

REMARKS

Reconsideration of the application is requested in view of the modifications above and the remarks below. Claims 1-12 are pending. Claim 12 has been amended for a informal matter. No new matter has been added.

Rejection Under 35 USC 102

The Office Action rejected Claims 1-2 under 35 USC 103(a) as unpatentable over Tetenbaum et al. The rejection should be withdrawn in view of the remarks below.

It is well settled that in order for a prior art reference to anticipate claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See Motorola Inc. v. Interdigital Technology Corp. 43 USPQ2d 1481 (1997 CAFC).

Applicants' invention is related to powdered thickener preparation produced by forming a solution, suspension or melt of a mixture comprising,

- a) at least one urethane group-containing, water-soluble or water-dispersible thickener,
- b) at least one substance solid at room temperature
- c) optionally a non-ionic, aromatic or aliphatic emulsifier and
- d) optionally other auxiliary substances and subsequently converting the products obtained into powder form by drying or grinding.

Applicants' invention includes a pulverulent thickener formulation that is extremely readily dispersible in water or aqueous paints and lacquers and that is composed of an inert, watersoluble or water-dispersible carrier material and a water-soluble polyurethane thickener active compound. For example, carrier materials are water-soluble, inert carrier materials, such as but not limited to, urea. In Applicants' invention the urea, due to the melting process by which it is produced, coats in a skin-like manner the thickener particles that are formed "in situ" from the polymer

Mo 6803

-4-

melt and that have a very small particle size. Thus, extremely effective dispersibility in aqueous formulations are produced, and particularly in aqueous paint and lacquer systems. Other known pulverulent products do not have this improved dispersability. In particular, other carrier materials, such as calcium carbonate, pyrogenic silicas, barium sulphate, titanium dioxide, cellulose, starch etc., do not produce such effective properties as the urea variants.

The Office Action alleges that "Tetenbaum discloses a powdered thickener at the abstract; column 12, lines 48-68 column 20, lines 50-59; and the remainder of the document " (Office Action, para 3).

Tetenbaum et al discloses a thickener formulation having a stabilizing agent (at least one clay compound of the smectite type according to claim 1(a)) and a waterdispersible polyurethane. Additional stabilizing agents mentioned are the bentonite and hectorite types. Tetenbaum et al discloses thermal stability with regard to the rheology of the aqueous systems mixed with the compounds. However, Tetenbaum et al does not disclose all the elements of Applicants' invention.

Further, Claims 3-4 and 10-12 depend from Claim 1, which as discussed is believed to be allowable. Accordingly, Claims 3-4 and 10-12 are also believed to be allowable. Reconsideration is requested.

Rejection Under 35 USC 103

The Office Action rejected Claims 1-21 under 35 USC 103(a) as unpatentable over Tetenbaum et al in view of Kanou et al and Smith. The rejection should be withdrawn in view of the remarks below.

It is well established that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification must have had a reasonable expectation of success, as determined from the vantage point of one of

Mo 6803

-5-

ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970). The Office Action did not establish a prima facie case of obviousness.

As discussed, Applicants' invention is related to a powder thickener preparations and has an extremely effective dispersibility in aqueous formulations, particularly in aqueous paint and lacquer systems. For example, in Applicants' invention, carrier materials are water-soluble, inert carrier materials, such as but not limited to, urea and a water-soluble polyurethane thickener active compounds.

The Office Action alleges that:

Tetenbaum discloses a powdered thickener at the abstract; column 12, lines 48-68; column 20, lines 50-59; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the referenced insoluble clays (ie. slurried clays) having the particle size of the instant claim 2 because such clays would have been expected to disperse in water more easily because of their increased surface areas. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the additional compounds of the instant claims 5-9 in the thickener compositions of the instant claims because Tetenbaum encompasses the use of additional ingredients in their thickeners, as evidenced by examples 10-14 and the instantly claimed ingredients are well known coating composition additives as shown by Smith, column 11, lines 28-55 and column 22, lines 33-66 and Kanou et al, column 6, lines 57-62. These compounds would have contributed their well known properties to the final composition in which they are used. (Office Action, page 4, section 4, para 1, to page 5, para 1).

Kanou et al and Smith et al disclose components used in paints and lacquers that do not produce effective dispersion properties. Neither, Kanou et al nor Smith et al teach or suggest lacquer components for use with a water-soluble, pulverulent thickener formulation, and it would not have been obvious to use as carrier materials for thickeners the coating components of Kanou et al or Smith et al. Thus, one skilled in the art would not have modified Tetenbaum et al using Kanou et al or Smith et al to practice Applicants' invention. Reconsideration is requested.

Mo 6803


-6-

Further, Claims 2-12 depend from Claim 1, which as discussed is believed to be allowable. Accordingly, Claims 2-12 are also believed to be allowable. Reconsideration is requested.

In view of the foregoing amendments and remarks, allowance of all the pending claims is earnestly requested.

Respectfully submitted,

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Mo 6803

-7-